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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,749	09/25/2003	Kevin P. Parker	PRKR-4100	2758
7590	07/26/2006		EXAMINER	
Philip A. Girard GIRARD & EQUITZ LLP Suite 1110 400 Montgomery Street San Francisco, CA 94104			GATES, ERIC ANDREW	
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 07/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/670,749	PARKER, KEVIN P.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric A. Gates	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11, 13-17, 19-21 and 23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 4-11, 13, 14, 19-21 and 23 is/are allowed.
- 6) Claim(s) 1-2 and 15-17 is/are rejected.
- 7) Claim(s) 3 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 5 May 2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. This office action is in response to Applicant's amendment filed on 5 May 2006.

### ***Drawings***

2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pierson et al. (U.S. Patent 6,010,157).

5. Regarding claim 1, Pierson et al. discloses a book binding apparatus 10 for binding a stack of sheets 12, said apparatus comprising: a first cover element 20

including a first cover section 18 having dimensions that generally correspond to dimensions of the sheets, with said first cover section 18 being disposed substantially exclusively in a single plane (see figure 3); a first section 48a of pressure sensitive adhesive disposed along a first edge 28 of the first cover section; a first release liner 50a disposed over the first section 48a of pressure sensitive adhesive; a flap member 44 attached to the first cover section 18 (through intermediate sections 38, 22, and 42) and pivotable at a first location 32 along the first cover section 18 (if sections 38 and 22 are put in contact with each other, sections 42 and 44 are pivotable about first location 32 along the first cover section 18), with the first location 32 being displaced from the first edge 28 of the first cover section 18 (as seen in figures 6 and 7), with said flap member 44 extending substantially along a full length of the first edge 28 of the first cover section 18 (when closed as seen in figure 7, if cover sections 16 and 18 are opened, the edge 36 of flap member 44 will extend substantially along the full length of edge 28 of cover section 18) and with at least a portion of the first section 48a of pressure sensitive adhesive being disposed intermediate the first location 32 and the first edge 28 (see figures 6 and 7); a second section 48b of pressure sensitive adhesive disposed on a surface of said flap member 44 facing said first release liner 50a; and a second release liner 50b disposed over said second section 48b of pressure sensitive adhesive, with said flap member 44 being movable between a closed position where the first release liner 50a can contact said second release liner 50b (if the middle sections 40 and 42 are folded along the edge 32 such that sections 40 and 42, as labeled in figure 4, are touching, then liners 50a and 50b will touch) and an open position where

the flap member 44 is positioned away from said first release liner 50a (as seen in figure 3).

6. Claims 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. Patent 4,511,298).

7. Regarding claim 15, Jones discloses a book binding apparatus 10 for binding a stack of sheets L, said apparatus comprising: a first cover element 12 including a folded sheet 12 having a fold 20 which separates the folded sheet into first 16 and second 18 cover sections, with the first and second cover sections each having dimensions that generally correspond to dimensions of the sheets of the stack of sheets L; and an elongated spine element 14 having a longitudinal first edge 26 (forms an edge when folded as shown in figure 8) attached to the folded sheet adjacent the fold 20 in the folded sheet 12, with a longitudinal second edge 24 of the spine element 14 not being attached to the folded sheet and with the spine element 14 including a substrate 14 and an adhesive matrix of heat activated adhesive (not shown, see column 3, lines 31-36) disposed on the substrate.

8. Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Giulie (U.S. Patent 4,385,225).

9. Regarding claim 15, Giulie discloses a book binding apparatus for binding a stack of sheets 25, said apparatus comprising: a first cover element 21 including a folded sheet 21 having a fold (not labeled, see figure 2) which separates the folded

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sheet into first and second cover sections (see figure 2), with the first and second cover sections each having dimensions that generally correspond to dimensions of the sheets of the stack of sheets 25; and an elongated spine element 12 having a longitudinal first edge 19 (edge formed by end 19 when folded as shown in bottom right of figure 3) attached to the folded sheet adjacent the fold in the folded sheet (see figure 2 and column 2, lines 14-16), with a longitudinal second edge (unattached edge of end 23) of the spine element 12 not being attached to the folded sheet and with the spine element 12 including a substrate 12 and an adhesive matrix of heat activated adhesive 14 disposed on the substrate.

10. Regarding claim 16, Giulie discloses wherein the adhesive matrix 14 defines a multiplicity of spaced apart longitudinal grooves that facilitate folding of the spine element.

#### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson et al. in view of DuCorday.

13. Regarding claim 2, Pierson et al. discloses a second cover element 16 comprising a second cover section 16 having dimensions that generally correspond to

dimensions of the sheets, with said second cover section being disposed substantially exclusively in a single plane (see figure 3); and an elongated spine element 22 having a longitudinal first edge 46 attached to an edge 56 of the second cover section 16 and a longitudinal second edge 40 to be secured by the first section 48a of pressure sensitive adhesive of the first cover section 18, with the spine element 22 including a substrate 46 and an adhesive matrix 48c disposed on the substrate 46.

Pierson et al. does not disclose that the longitudinal second edge is a free longitudinal edge. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the spine section separate from the first cover section for the purpose of attaching different spine sections and cover sections together, because it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)

The modified invention of Pierson et al. does not disclose said adhesive matrix is made of heat activated adhesive. DuCorday teaches the use of a heat activated adhesive matrix 26 disposed on the spine 10 for the purpose of providing a strong adhesive bond. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of Pierson et al. with the adhesive of DuCorday in order to have a binder with stronger adhesion to the sheets to be bound.

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14. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Giulie.

15. Regarding claim 16, Jones discloses the invention substantially as claimed, except Jones does not disclose wherein the adhesive matrix defines a multiplicity of spaced apart longitudinal grooves that facilitate folding of the spine element.

Giulie teaches the use of a heat activated adhesive matrix that comprises a multiplicity of spaced apart longitudinal grooves 17 for the purpose of facilitating folding of a spine element 12. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of Jones with the adhesive matrix of Giulie in order to have a spine element that is easier to fold.

16. Regarding claim 17, the modified invention of Jones discloses wherein the elongated spine element 14 further includes a pressure sensitive adhesive 28 disposed along the longitudinal second edge 24 of the spine element and a release liner 30 disposed over the pressure sensitive adhesive.

#### ***Allowable Subject Matter***

17. Claims 4-11, 13-14, 19-21, and 23 are allowed.

18. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

19. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.
20. For the reasons as set forth above, the rejections are maintained.

***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Monica S. Carter*  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER

*EAG*

20 July 2006